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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,345	12/01/2003	Stig Bakke	MRKS/0130	1281

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EXAMINER

COLLINS, GIOVANNA M

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,345

Applicant(s)

BAKKE, STIG

Examiner

Giovanna M. Collins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 7 and 9-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7 and 9-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/1/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claim 7 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 7 only recites, "the work tool is a cutting tool". Claim 7 depends from claim 1 which recites, "the work tool is a high pressure water cutter". Therefore, claim 7 does not further limit the limitation of claim 1.

Claim 20 is objected to because the recites the limitation "the work area" in line 8. There is insufficient antecedent basis for this limitation in the claim, as this limitation has not been previously recited.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-4,6-7,9-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nazzal 6155343 in view of Newman et al. 5794703.

Referring to claims 1,3-4,14,15, and 20-21, Nazzal discloses an apparatus for orientating a work tool, the apparatus comprising an first and second anchor (40a,40b), an energy unit (34), a programmable controller (36), and a rotational part (28) configured to orient the work tool around a longitudinal axis of the apparatus, the rotational part being controllable by the programmable controller so that the work tool can be steered along any path within a work area (col. 4, lines 22-26), the work tool (30) is a high pressure water cutter (150), the relative position of the telescopic member is transmittable to the controller by means of a position transmitter and the relative position of the rotational part is transmittable to the controller by means of an angle transmitter (col. 5, lines 23-24). Nazzal does not disclose an axial displacement part between the two anchors. Newman teaches an axial displacement part between two anchors (see figs. 3a-3c) that allows a tool to be moved through a wellbore (col. 2, lines 30-42). As it would be advantageous to move the tool to different sections of the wellbore it would be obvious to one of ordinary skill in the art to modify the apparatus disclosed by Nazzal to have an axial displacement part between the two anchors in view of the teachings of Newman.

Referring to claims 2 and 10, Newman teaches the axial displacement part (30) comprises a telescopic member that is a piston rod (fig. 5, at 417).

Referring to claims 6-7, Nazzal discloses cutter tool (30) is coupled to the rotational part (col. 4, lines 19-21).

Referring to claims 9 and 19, Nazzal discloses a method of orientating a cutting tool in a cased wellbore, comprising setting an anchor (40a) in a cased wellbore; and

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directing the work tool with an axial displacement part (30) and a rotational part (28) operably connected to the anchor, wherein the rotational part is controlled by a programmable controller (col. 4, lines 22-26). Nazzal does not disclose releasing the first anchor and moving the first anchor to a new position. Newman teaches an axial displacement part is positioned between the first anchor and the second anchor, and releasing the first anchor moving the first anchor to a new position in the wellbore; setting the first anchor at the new position and releasing the second anchor (figs 3a-3c). Newman teaches an axial displacement part between two anchors (see figs. 3a-3c) that allows a tool to be moved through a wellbore (col. 2, lines 30-42). As it would be advantageous to move the tool to different sections of the wellbore it would be obvious to one of ordinary skill in the art to modify the method disclosed by Nazzal to have an axial displacement part between the two anchors and moving the anchors to new positions in view of the teachings of Newman.

Referring to claims 11-12, Nazzal disclose the rotational part (28) is coupled to a second anchor and telescopic part.

Referring to claim 16, Nazzal discloses the work tool (32) can cut through a cased wellbore.

Referring to claim 17,18, Nazzal discloses the rotational part (28) is configured to orient the work tool around a longitudinal axis of the apparatus.

2. Claims 1-4,6-7,9-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jennings 6012526 in view of Newman et al. 5794703.

Referring to claims 1,3-4,14,15, and 20-21, Jennings discloses an apparatus for orientating a work tool, the apparatus comprising an anchor (138), an energy unit (120), a programmable controller (152), and a rotational part (col. 11, lines 50-62) configured to orient the work tool around a longitudinal axis of the apparatus, the rotational part being controllable by the programmable controller so that the work tool can be steered along any path within a work area, the work tool (116) is a high pressure water cutter (150), the relative position of the telescopic member is transmittable to the controller by means of a position transmitter and the relative position of the rotational part is transmittable to the controller by means of an angle transmitter (col. 5, lines 23-24).

Jennings does not disclose an axial displacement part between two anchors. Newman teaches an axial displacement part between two anchors (see figs. 3a-3c) that allows a tool to be moved through a wellbore (col. 2, lines 30-42). As it would be advantageous to move the tool to different sections of the wellbore it would be obvious to one of ordinary skill in the art to modify the apparatus disclosed by Jennings to have an axial displacement part between the two anchors in view of the teachings of Newman.

Referring to claims 2 and 10, Newman teaches the axial displacement part (30) comprises a telescopic member that is a piston rod (fig. 5, at 417).

Referring to claims 6-7, Jennings discloses a cutter tool (112) is coupled to the rotational part (col. 11, lines 50-62).

Referring to claims 9 and 19, Jennings discloses a method of orientating a cutting tool in a cased wellbore, comprising setting an anchor (138) in a cased wellbore; and directing the work tool with a rotational part (col. 11, lines 50-62) operably

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connected to the anchor, wherein the rotational part is controlled by a programmable controller (152). Jennings does not disclose releasing the first anchor or moving the first anchor to a new position. Newman teaches an axial displacement part is positioned between a first anchor and a second anchor, and releasing the first anchor moving the first anchor to a new position in the wellbore; setting the first anchor at the new position and releasing the second anchor (figs 3a-3c). Newman teaches an axial displacement part between two anchors (see figs. 3a-3c) that allows a tool to be moved through a wellbore (col. 2, lines 30-42). As it would be advantageous to move the tool to different sections of the wellbore it would be obvious to one of ordinary skill in the art to modify the method disclosed by Jennings to have an axial displacement part between the two anchors and moving the anchors to new positions in view of the teachings of Newman.

Referring to claims 11-12, Jennings discloses the rotational part (col. 11, lines 50-62) is coupled to an anchor and a telescopic part.

Referring to claim 16, Jennings discloses the work tool (116) can cut through a cased wellbore.

Referring to claim 17,18, Jennings discloses the rotational part (col. 11, lines 50-62) is configured to orient the work tool around a longitudinal axis of the apparatus.

Response to Arguments

3. Applicant's arguments with respect to claims 1-4,6-7,9-21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna M. Collins whose telephone number is 571-272-7027. The examiner can normally be reached on 6:30-3 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


gmc


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